

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

In the drawings

Revised Fig. 7 is shown in the "Replacement Sheets" of drawing appended herewith. Reference numbers shown on Fig. 7 have been corrected for consistency with reference numbers identified in the discussion of Fig. 7 in the specification.

Rejection of claims 1 and 2 under 35 U.S.C. § 103(a)

Claims 1 and 2 presently stand rejected as being unpatentable over Tychsen (U.S. 6,711,869) in view of Oh et al (U.S. 6,546,687). This rejection is respectfully traversed for the following reasons.

Claim 1 has been amended by incorporating the limitations set forth in claim 2, and claim 2 has been cancelled.

It is respectfully submitted that the Tychsen and Oh fail to form a prima facie case of obviousness of claim 1 of the present application, and therefore claim 1 is allowable over the cited references.

Tychsen discloses a floor board with joints comprised of an opposing tongue and notch structure, wherein a generally horizontal tongue is inserted into a generally horizontal notch to join adjacent edges of adjacent boards. Accordingly, a floor board is joined to previously laid boards by placing the board on a subfloor surface proximate to the previously laid boards and sliding the board, in both longitudinal and transverse directions, so that the horizontally oriented tongue and notch are joined along both longitudinal and transverse edges.

Oh discloses plastic waterproofing panels that employ a tongue and groove structure for joining adjacent edges of adjacent panels. The structure disclosed by Oh

includes a vertical tongue adjacent to a groove, such that edges of adjacent panels are joined by interlocking the tongue and groove vertically (see *Oh*; figs. 1, 5, and 6). Given the vertical nature of the tongue and the groove, adjacent panels cannot be joined by sliding the panels horizontally together.

While the examiner acknowledges that “Tychsen does not disclose or suggest two transverse tongues having a width and defined respectively on the sides different from the longitudinal notch and the longitudinal tongue; and two transverse grooves having a width equal to the width of the transverse tongues and defined respectively beside the transverse tongues,” the examiner asserts that it would have been “obvious to modify Tychsen” according to the teachings of *Oh*. Applicant respectfully disagrees.

It is respectfully submitted that there is no motivation or suggestion for combining the teachings of Tychsen and *Oh* to arrive at the present invention. On the contrary, it is respectfully submitted that Tychsen cannot be modified to use the vertically oriented tongue and groove structure of *Oh*, since such a modification of Tychsen would eliminate the ability to slide adjoining floor boards together.

Accordingly, modification of Tychsen according to the teachings of *Oh* would render Tychsen unsatisfactory for its intended purpose, since floor boards would no longer be able to be joined by sliding the boards together if so modified. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Similarly, such a modification of Tychsen according to the teachings of *Oh* would change the principle of operation of Tychsen since floor boards would require joining by vertical engagement of adjacent boards, which is a different manner than that taught by Tychsen. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

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Because there is no motivation or suggestion for the combination of Tychsen and Oh, the cited references fail to establish a prima facie case of obviousness of the present invention. Therefore, it is respectfully submitted that claim 1 is allowable over the cited references, and withdrawal of the rejection is respectfully requested.

Conclusion


In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claim 1 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's attorney, the Examiner is invited to contact the undersigned at the numbers shown.

Respectfully submitted,

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